

**RECEIVED
CENTRAL FAX CENTER****OCT 31 2006**Patent

112.P14031

REMARKS

The above-referenced patent application has been reviewed in light of the Office Action referenced above. Reconsideration of the above-referenced patent application in view of the following remarks is respectfully requested.

Claims 1-19 are pending in the application. Claims 1, 5, 6, 10, 13, 14, and 17 have been amended to improve the clarity of the claim language. New claims 20-39 have been added. The amendment is fully supported by the original disclosure. No new matter has been introduced. Assignee asserts that no prosecution history estoppel should result from the above amendments where the amendments were made to clarify Assignee's claims and/or broaden scope of the amended claims

Allowed subject matter:

Assignee thanks the Examiner for the allowance of method claims 10-15.

In response, Assignee has provided new article of manufacture claims 20-25 as well as apparatus claims 30-35 based on allowed of method claims 10-15. Accordingly, Assignee submits new article of manufacture claims 20-25 as well as apparatus claims 30-35 are in condition for allowance.

Claim rejections – 35 USC §102

Claims 1, 2, 7, and 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Takahashi et al. (U.S. Patent No. 5,583,662). These rejections are respectfully traversed.

112.P14031

Patent

Assignee respectfully submits that Takahashi does not disclose all of the elements of independent claim 1. The Examiner is kindly reminded that the Examiner's initial burden of factually supporting any conclusion of anticipation includes that:

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. (See MPEP § 2131.01.)

First, the Examiner has not established that Takahashi discloses *scanning a smooth image region ... wherein the smooth image region comprises a uniform brightness, to obtain a smooth image data*", as recited in claim 1. In the Office Action the Examiner has asserted that:

Takahashi et al. discloses ... scanning a smooth image region, (scanner 101 of fig 1 and 2, reads a document) wherein the smooth image region includes at least the original pixels with the predetermined number and has a uniform brightness, (the quantities of the light are controlled to a predetermined adequate quantity by feed back control, see col. 9, lines 45-60, and (col. 10, lines 10-15) to obtain a smooth image data, see (there by preventing the density read out of the document from becoming irregular, see (col. 10, lines 1-5). (See page 3 of the Office Action).

Assignee cannot agree. Specifically, even assuming for the sake of argument that Takahashi et al. discloses controlling quantities of light, the Examiner has not established any nexus between the type and/or quality of light output of the device of Takahashi with a the claimed properties of the *"smooth image region"* that is to be scanned, as recited in claim 1. Assignee fails to see the relevance that quantities of light have to the claimed properties of the *"smooth image region"* wherein the smooth image region itself *"comprises a uniform brightness"*. Further, while the Examiner has generally referred to a "document" of Takahashi, the Examiner has not established that the "document" itself has the claim property of a *"smooth image region"* wherein the smooth

112.P14031

Patent

image region itself "*comprises a uniform brightness*". In the absence of the Examiner pointing to such a disclosure in Takahashi, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that Takahashi discloses the identical invention as is required for anticipation. See MPEP § 2131.

Second, the Examiner has not established that Takahashi discloses "*scanning a smooth image region... and ... processing scanned images obtained by scanning a document according to the smooth image data*", as recited in claim 1. In the Office Action the Examiner has asserted that:

Takahashi et al. discloses ... scanning a smooth image region, (scanner 101 of fig 1 and 2, reads a document) ... and processing scanned images obtained by scanning a document according to the smooth image data, see (col. 7, lines 40-45). (See page 3 of the Office Action).

Assignee cannot agree. Specifically, the Examiner has not established that Takahashi discloses both "*scanning a smooth image region*" as well as "*scanning a document according to the smooth image data*", as recited in claim 1. Even assuming for the sake of argument that Takahashi et al. discloses scanning a document, the Examiner has neither established that any portion of the document would anticipate a "*smooth image region ... wherein the smooth image region comprises a uniform brightness*", nor established that any "*scanned images obtained by scanning a document*" be processed "*according to the smooth image data*", as recited in claim 1. Similarly, regarding independent claim 16, the Examiner has neither established that any portion of the document would anticipate a "*smooth image region with a uniform brightness*", nor established that a "*calculated brightness for at least a portion of a second image region*" be based at least in part on "*a standard brightness from the smooth image region*". In the absence

*112.P14031*Patent

of the Examiner pointing to such a disclosure in Takahashi, Assignee requests that the rejection be withdrawn as the Examiner has failed to establish that Takahashi discloses the identical invention as is required for anticipation. See MPEP § 2131. Claims 2, 7, 16-19, 26-29, and 36-39 are similarly not anticipated, at least on the same or similar basis as claim 1.

It is noted that claimed subject matter may be patentably distinguished from the cited references for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

RECEIVED
CENTRAL FAX CENTER

112.P14031

OCT 31 2006

Patent

Conclusion

In light of the foregoing, reconsideration and allowance of the claims is hereby earnestly requested.

Any fees or extensions of time believed to be due in connection with this amendment are enclosed herein; however, consider this a request for any extension inadvertently omitted, and charge any additional fees to Deposit Account 50-3703.

Invitation for a Telephone Interview

The Examiner is invited to call the undersigned attorney, James J. Lynch, at (503) 439-6500 if there remains any issue with allowance.

Respectfully submitted,
Attorney for Assignee

Dated: October 31, 2006

/James J. Lynch Reg. No. 50,153/
James J. Lynch
Reg. No. 50,153

Customer Number: 00043831

Berkeley Law & Technology Group, LLC
1700 NW 167th Place, Suite 240
Beaverton, OR 97006
503.439.6500